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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,825	01/18/2002	Leslie Jones	39872-177641	6945

7590

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Andrew C. Aitken

VENABLE

Post Office Box 34385

Washington, DC 20043-9998

EXAMINER

HOWELL, DANIEL W

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,825

Applicant(s)

JONES ET AL

Examiner

Daniel W. Howell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 17 is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. Applicant's arguments with respect to claims 1 and 3-13 have been considered but are moot in view of the new ground(s) of rejection.

2. Claims 1, 3-7, and 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Lines 17-18 of claim 1 as amended state that the patch has a thickness **less than** the distance from the cutting surface of said rebate blade to said flange member. For the specification as originally filed, lines 19+ of claim 7 state that the patch "is provided that closely conforms to the dimension of the hole." Lines 4-5 of page 9 of the specification as originally filed state, "The top surface 62 of the patch is within the same plane as the exterior surface 65 of the gypsum board." Neither of these two locations in the specification as originally filed provide basis for a patch having a dimension smaller than the depth of the counterbore. The only thing disclosed by the specification as originally filed is a patch of the same dimension of the depth of the counterbore. [The examiner is aware that a substitute specification was filed on March 26, 2002, but the above rejection has been referenced to the line numerals of the original specification.]

3. In the rejections below, the examiner will treat claim 1 as if it sets forth a patch having the same thickness as the depth of the counterbore.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-13 rejected under 35 U.S.C. 102(b) as being anticipated by UK '198. Figure 4 shows a countersunk hole in a panel and a patch/cover 32 which seats on surface 12. Figure 7 shows a detachable hole saw 58 for forming the hole and axially rearwardly spaced rebate blades 20 for forming the counterbore. Flange 24 limits the depth of the counterbore. Note cutting surfaces 22 on base member 20, and the two blades are spaced angularly around the hole saw. The diameter of the patch must clearly be less than the diameter of the counterbore. Lines 55-57 of page 1 state that the surface of the cover plate is flush with the material (panel), which is just what Applicants' specification has disclosed. See shank 44 which fits into drill 48. Lines 82-86 of page 2 state that bar 80 may be a conventional and detachable pilot drill bit. With respect to claim 9, lines 12+ of page 1 discuss bringing in electricians at a later time to wire a plurality of houses. It is considered to have been inherent that the electricians could have accessed the interior space at the time of making the hole, as that is what electricians have been doing since houses have been provided with electrical wiring. Regarding claim 10, since a group of houses will be built, it is also inherent that the operator have a plurality of patches to cover all of the holes made in the group of houses.

6. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "inner annular hole saw" of claim 16 should be changed to "cylindrical hole saw" to be consistent with line 1 of claim 15.

7. On line 6 of claim 8, parallel should be properly spelled, and on line 2 of claim 11, "wherein" should be properly spelled.

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8. Claims 15 and 17 are allowed.
9. Claim 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
10. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 703-308-1728. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 703-308-2159.

Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Center for Tech Center 3700 at 703-306-5648.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1148.



Daniel W. Howell
Primary Examiner
Art Unit 3722